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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WOLFGANG MATTHES, LUTZ RICHTER, and ANDREAS
STEINERT

Appeal 2009-014496
Application 09/848,583
Technology Center 3700

Before: JENNIFER D. BAHR, JOHN C. KERINS, and STEVEN D. A.
MCCARTHY, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting under § 103(a) claims 1-4, 6, 7, 10, and 14 as unpatentable over Ito (US 4,922,773, iss. May 8, 1990), Besemann (US 4,523,502, iss. Jun. 18, 1985), Boss (US 6,536,319, iss. Mar. 25, 2003), and Hartlage (US 4,505,173, iss. Mar. 19, 1985) and claims 8 and 9 as unpatentable over Ito, Besemann, Boss, Hartlage, and Cannon (US 4,553,080, iss. Nov. 12, 1985). Claims 5, 12, and 13 have been canceled. Claim 11 has been withdrawn. We have jurisdiction under 35 U.S.C. § 6(b).

Claim 1 reproduced with added emphasis below, is illustrative of the claimed subject matter:

A cutting device for trimming margins of products, comprising:
a first cutting station having a first cutting knife;
a second cutting station following said first cutting station in a transport direction and receiving the products from said first cutting station, said second cutting station having further cutting knives;
a transport device having a course of motion and front stops for aligning the products;
a first drive for driving said transport device;
a stroke device for moving said first cutting knife and said further cutting knives in a knife motion for performing the trimming of the margins; and
a second drive for driving said stroke device;
said first drive and said second drive being embodied as separate, mutually independent drives, and both of said drives being connected to one another via *a control system configured for setting the course of motion of said transport device to the knife motion as a function of product format, and said control system configured for controlling said first drive to set an impact speed of the products at said front stops as a function of product format.*

SUMMARY OF DECISION

We AFFIRM.

OPINION

With respect to claim 1, the Examiner found that Ito describes a cutting device having a cutter (stroke device) synchronized with a conveyor (transport device), but that Ito does not explicitly teach that they are connected via a control system for setting the course of motion as a function of product format. Ans. 4 (the Examiner notes, however, that the control system could be assumed to be described in Ito). The Examiner next found that Besemann describes a cutter and conveyor synchronized via a control system. *Id.* In addition, the Examiner found that it is old and well known to link a cutter and a transport device based on the format of the work piece because "without taking into account the product format, the wrong cut may occur." Ans. 9. The Examiner also found that it is old and well known to use a speed appropriate to the particular format of the product so as not to damage the product from hitting the stops too hard. Ans. 6. The Examiner reasons that it would have been obvious to a person of ordinary skill in the art to "pursue the known options within [their] technical grasp." Ans. 6, 9-10.²

² The Examiner's rejection additionally includes findings and conclusions with respect to Boss and Hartlage. Ans. 5-6. However, Appellants do not challenge the Examiner's findings or conclusions with respect to these references. Appeal Br. 7-8. Thus, we do not discuss these aspects of the rejection.

Appellants argue that the rejection does not properly address a control device configured to perform certain actions "as a function of product format." Appeal Br. 5-7. Instead, Appellants argue, Besemann teaches (in discussing Neubueser) transferring sheets based upon a quantity or number of sheets, not a product format. *Id.* at 6-7.

Therefore, the issue before us is whether the Examiner properly concluded that the teachings of Ito, Besemann, Boss, and Hartlage render obvious a cutting device, as recited in claim 1, having a "a control system configured for setting the course of motion ... as a function of product format, and ... controlling ... an impact speed of the products ... as a function of product format."

The Examiner makes it clear that Besemann is used to teach synchronizing a cutter and a transfer device via a computer. Ans. 8. The Examiner finds that synchronizing these operations requires taking into account the product format to prevent processing errors. Ans. 9. In other words, common sense dictates that in order to prevent processing errors, one must synchronize the course of motion of the transport device to the motion of the knife, taking into account the materials being transported and cut. Thus, one of ordinary skill in the art would have a reason to set the course of motion of the transport device to the knife motion based on the product format, because without taking into consideration product size and shape, for example, the cutting device would not be able to accurately place the product (using the transport device) in the correct location at the time of the cut to make the appropriate cut (using the knives). *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) ("the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative

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steps that a person of ordinary skill in the art would employ"); *see also Perfect Web Tech., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009) ("while an analysis of obviousness always depends on evidence ... it also may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference").

Further, "when a patent claims a genus by its function or result, [the written description provision of 35 U.S.C. § 112, second paragraph, requires that] the specification [recite] sufficient materials to accomplish that function." *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010). However, "a patent need not teach, and preferably omits, what is well known in the art." *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick*, 730 F.2d 1452, 1463 (Fed. Cir. 1984)). Therefore, given that Appellants' Specification is lacking any description of the functions that set the course of motion based on the product format, it is clear that Appellants consider the means for accomplishing those functions to be within the technical grasp of a person of ordinary skill in the art. Claiming well known control functions used in similar machines in the same way is unlikely to distinguish the present invention over the prior art. *See KSR*, 550 U.S. at 415-16 (a "patent for a combination which only unites old elements with no change in their respective functions ... obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men.") (*quoting Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.*, 340 U.S. 147, 152-153 (1950)).

Likewise, with respect to controlling an impact speed of the products as a function of product format, such a capability is, again, common sense. As the Examiner states, if a product (e.g., copy paper) were sped too fast up against the stops, it could be damaged. Ans. 6. Thus, it is common sense that the format of the product must be taken into consideration, at least to some extent, to prevent damage to the product from hitting the stops too hard. As above, Appellants' Specification does not describe the function that controls the impact speed of the products, such that it is clear Appellants consider the accomplishment of this function to be within the technical grasp of a person of ordinary skill in the art. *See Ariad*, 598 F.3d at 1352; *Hybritech*, 802 F.2d at 1384; *see also KSR*, 550 U.S. at 416-17.

Accordingly, the Examiner's conclusion that Ito, Besemann, Boss, and Hartlage render obvious a cutting device, as recited in claim 1, having "a control system configured for setting the course of motion ... as a function of product format, and ... controlling ... an impact speed of the products ... as a function of product format" has rational underpinning, premised on common sense, because if a device did not take into account the format of a product or the speed at which it moves, for example, the product would not be properly cut or could be damaged. Appellants have not raised any compelling arguments that would tend to refute the Examiner's conclusion. Therefore, we sustain the Examiner's rejection of claim 1 and of claims 2-4, 6, 7, 10, and 14, which Appellants argue as a group with claim 1. 37 C.F.R. § 41.37(c)(1)(vii). Appellants separately argue claims 8 and 9 but rely on the unpersuasive arguments presented for claim 1. Thus, we sustain the Examiner's rejection of claims 8 and 9.

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DECISION

For the above reasons, we affirm the Examiner's decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

mls

LERNER GREENBERG STEMER LLP
P.O. BOX 2480
HOLLYWOOD, FL 33022-2480